IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

No. 17771 ✓

DRESSER INDUSTRIES, INC., a Corporation,

Appellant,

vs.

SMITH-BLAIR, INC., a Corporation,

Appellee.

PETITION FOR REHEARING

EDWARD B. GREGG,
Attorney for Petitioner.

Of Counsel:

ROBERT E. BURNS,
150 Nassau Street,
New York 38, New York.

FILED
NOV 14 1963
FRANK H. SCHMID, CLERK

IN THE

United States Court of Appeals
FOR THE NINTH CIRCUIT

No. 17771

Dresser Industries, Inc., a Corporation,
Appellant,

vs.

Smith-Blair, Inc., a Corporation,
Appellee.

PETITION FOR REHEARING

Appellant respectfully petitions for rehearing on the round that the decision of this Honorable Court is conrary to law and in violation of the Constitution of the Jnited States.

1. The decision incorrectly applies the standard of nvention of the A & P Case (*Great Atlantic & Pacific Tea 'o. v. Supermarket Equipment Corp.,* 340 U. S. 147) and tates "the A & P Case . . . continues to be the law." ontrary to the Patent Act of 1952 and Art. 1 Sec. 8 of he Constitution. Congress has plenary powers to legislate n the subject of patents and there can be no limitation of ts right to modify the patent law. (*McClurg* v. *Kingsand,* 42 U. S. 202, 11 L. Ed. 102.) In enacting the Patent ct of 1952, Congress defined the requirements of patentbility and stated expressly that a "person shall be ntitled to a patent" if these requirements are met (35 JSC 101-103). This Court does not have the power to et or apply standards of patentability different from hose enacted by Congress.

2. The Court reached a conclusion that the invention s obvious by a side-by-side and part-by-part comparison f components and ignored compelling objective evidence hat the subject matter as a whole was not obvious at the ime the invention was made to a person having ordinary

skill in the art to which the subject matter pertains as prescribed by 35 USC 103, contrary to its decision in *Stearns* v. *Tinker & Rasor,* 220 F. 2d 49 and contrary to decisions in other circuits: *Reiner* v. *I. Leon Co., Inc.,* 285 F. 2d 501 (CA 2), *Honolulu Oil Corp.* v. *Shelby Poultry Co.,* 293 F. 2d 127 (CA 4), *National Latex Products Co.* v. *Sun Rubber Co.,* 274 F. 2d 224 (CA 6), *Mott Corp.* v. *Sunflower Industries, Inc.,* 137 USPQ 288, —— F. 2d —— (CA 10).

3. The holding that the Lindsay British patent is analogous art on the basis of an element-by-element comparison is contrary to the law as stated by this Court in *Stearns* v. *Tinker & Rasor,* 220 F. 2d 49 that even if a similarity of elements is assumed, an art is not analogous if there is no similarity of purpose of the device as a whole. As the present case cannot be distinguished from Stearns, the decision amounts to a *sub silentio* repudiation and overruling of Stearns and is contrary to the law established in other circuits, e.g. *Mott Corp.* v. *Sunflower Industries, Inc.,* 137 USPQ 288, —— F. 2d —— (CA 10).

4. The decision denying appellant's request for remand for consideration of the Patent Office files of two of appellee's patent applications, access to which had been denied to appellant by the District Court, is contrary to the law enunciated in *James B. Clow & Sons, Inc.* v. *U. S. Pipe & Foundry Co.,* 313 F. 2d 46 (CA 5). An examination of these files, which have now become public through issuance of the patents, and an examination of a part of the file of a corresponding Canadian patent application which would have been uncovered had the District Court granted appellant's motion during discovery proceedings, discloses that they relate to the fundamental issues of analogy of prior art and the presumption of validity as well as the issue of who was the first inventor—the identical issue involved in the *Clow* case.

5. The decision holds that the Lindsay patent rebuts any presumption of validity attaching to the grant of the

oke patent contrary to the decision of this Court in *tearns* v. *Tinker & Rasor* (*supra*) that the presumption f validity is not rebutted by a patent showing only a omponent in a different environment. The presumption f validity is based on the expertise of the Patent Office. the Trial Court had granted appellee's motion to inpect the files of appellee's patent applications, the inspecon would have revealed that the Patent Office did not te Lindsay against appellee's patent application on the ccused pipe clamp, now patent No. 3,089,212 and did not nclude Lindsay in the list of prior art on the patent even hough the applicant called Lindsay to the attention of he Patent Office. Appellee has now been granted two atents (2,998,629 and 3,089,212) on sliding finger pipe epair clamps, indicating that the Patent Office does not onsider Lindsay pertinent to pipe repair clamps.

6. The decision construes the term "clamp" to mean clamping component" and then proceeds to compare the clamping component" with the "clamp" of the Lindsay British patent, contrary to *Oregon Saw Chain Corp.* v. *IcCulloch Motors Corp.* —— F. 2d —— (CA 9, Decided October 9, 1963) holding that the claim of a patent is to e interpreted in the light of its specification. The specication as well as the custom in the trade makes it clear hat the "clamp" is the entire device including flexible and, gasket, lugs and bolts. When properly interpreted here is no similarity of structure or purpose between the exible band type pipe repair clamps of the Hoke patent nd the hook bolt adapters of Lindsay. In this connection he Court said (page 7):

> "If the word 'clamp' means the whole patent device, then a comparison of the Hoke patent, with the Lindsay patent, will indicate a clear difference."

7. The decision holds that eleven findings challenged y appellant are not clearly erroneous because they are mbiguous, contrary to the decision of this court in *Velsch Co. of Calif.* v. *Strolee of Calif., Inc.*, 290 F. 2d

509 and *National Lead Co.* v. *Western Lead Products Co* 291 F. 2d 447 that the findings should be so explicit as t give the appellate court a clear understanding of the basi of the trial court's decision and enable it to determine th ground on which the trial court reached its decision Explicit and unambiguous findings are of particular im portance when the trial court writes no decision. Whe findings are prepared by counsel and not even edited b the court, this decision puts a premium on ambiguit rather than explicitness. Furthermore, this court faile to exercise its jurisdiction within the scope of review pro vided by *Costello* v. *Fazio,* 256 F. 2d 903 (CA 9) an other cases in this and other circuits which state that th "clearly erroneous" rule is not applicable to "findings which are merely conclusions.

8. Finally, reconsideration is requested of the decisio by the Court that the entire patent is invalid. On pag 18 the Court states:

> "The term 'clamping component' is used becaus only Hoke claims 1 to 8 are in issue. The com ponent that secured the ends of the band to th lugs is described in claims 8 through 12."

Although appellee has contended that the "clamping com ponent" is anticipated by Lindsay, even appellee admit that there *was* a problem in using sliding fingers *in com bination* with satisfactory means for securing the end of the band to the lugs. (Finding 19.) While a court ca hold invalid claims not charged to be infringed, appellat courts wisely refrain from ruling on issues which hav not been tried below. *Yavitch* v. *Seewack* (CA 9), 13 USPQ 102, —— F. 2d ——. It is well established tha some claims of a patent may be valid even though other are held invalid. *Pursche* v. *Atlas Scraper,* 300 F. 2 467 (CA 9).

Request for Rehearing *En Banc*

Pursuant to Rule 23(5) of the Rules of this Court, appellant respectfully requests the rehearing of this appeal

n banc. Western P.R. Corp. v. *Western P.R. Co.,* 345 J. S. 247 (1952).

The Constitution vests in Congress the *sole* power to stablish the legal criteria of patentability. Congress as established such criteria in the Patent Act of 1952 vhich supersedes those of the earlier *A & P* case and herefore, the application of those judicial criteria is an nconstitutional usurpation of the power of Congress. The standard of patentability is a constitutional standrd." *Pressteel Co.* v. *Halo Lighting Products, Inc.* CA 9), 137 USPQ 25, —— F. 2d ——. (Decided March 6, 963.)

It is submitted that the constitutional implications of he decision and the issues of law presented are of suffiient importance to warrant a rehearing *en banc.*

Respectfully submitted,

Edward B. Gregg

Edward B. Gregg,
Attorney for Petitioner.

)f Counsel:

Robert E. Burns,
150 Nassau Street,
New York 38, New York.

Dated this 12th day of November 1963.

Certificate

The undersigned, Edward B. Gregg certifies that in his udgment the foregoing Petition for Rehearing is well ounded and in full compliance with the Rules of this Court and that it is not imposed for delay.

Edward B. Gregg

Edward B. Gregg,
Attorney for Petitioner.

See also Vol. 3186

No. 17816

IN THE UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

ACIFIC COAST CHEESE, INC., and EVERT L. HAGAN, Appellants

=v=

. WILLARD WIRTZ, Secretary of Labor, United States Department

of Labor, Appellee

++++

ppeal from the United States District Court for the Southern

District of California

====

APPELLANTS PETITION FOR RE-HEARING

====

JESSE A. HAMILTON,

115 North Eastern Avenue,
Los Angeles 22, California.

Attorney for Appellants.

INDEX

	Page
PETITION	3, 4
CERTIFICATION	5

REFERENCE CITED

Page

Pge 242 , (Lines 14, through 19) Transcript 4

CIFIC COAST CHEESE, INC.,)
d EVERT L. HAGAN)
) No. 17816
Appellants)
) PETITION FOR RE-HEARING
=v=)
)
WILLARD WIRTZ, Secretary)
Labor, U. S. Department of)
bor.)
)
Appellee)

TO: THE HONORABLE JUSTICES OF THE NINTH CIRCUIT COURT OF APPEALS.

COMES NOW PACIFIC COAST CHEESE, INC., and EVERT L. HAGAN, and spectfully petition the above Court for a re-hearing in the above tter.

Said petition is made upon the following grounds:

1. After the remand upon the first appeal, the trial court s of no disposition to allow the production of evidence and actically forced the stipulation concering the review of the case, on appellants.

2. The trial court did not, in fact base his second judgment on the basis of burden of proof, but rather based it upon dislike appellants or their previous counsel.

3. The trial court did not follow the Mandate of this Court on the first appeal. In this connection, and regardless of the ial court's concept of the burden of proof, the trial court nored the matter of the five cents per hour. There was evidence

n the record, from which these matters could be computed. On page 242, of transcript there appears the following, (lines 14, through 19):

" MR. McMULLEN: There is one thing, if I may bring it up, sir, that has not been properly done before this court, and that is the ammount of five cents an hour. I believe that could be easily computed.

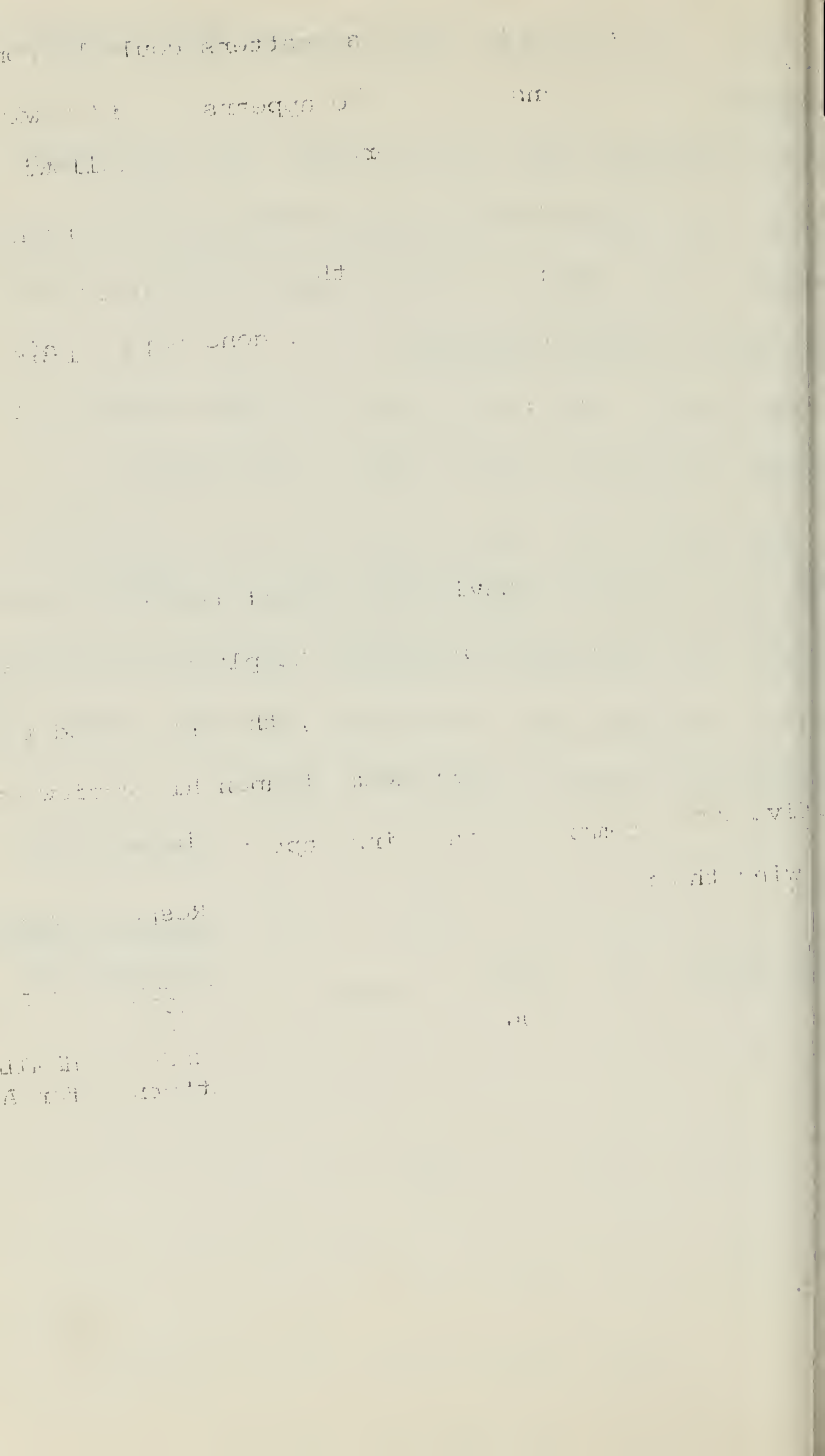
" THE COURT: Let's wait until I decide whether or not that is going to be an issue in this case."

The trial court having arrived at the conclusion at the end of the trial that he disbelieved the plaintiffs' witnesses and believed the defendants' witnesses, then proceeded to ignore the five cents per hour arrangement upon his review of the case following the remand on the first appeal.

Respectfully submitted:

JESSE A. HAMILTON,
Attorney for Appellants.

Dated: March 10, 1963



CERTIFICATION

I certify that in my judgment the foregoing petition is well ınded and that it is not interposed for delay. I further certify ıt, in connection with the preparation of this petition, I have ımined Rules 18 and 19, for United States Circuit Court of ɔeals, for the Ninth Circuit, and that, in my opinion, the :regoing petition is in full compliance with these rules.

JESSE A. HAMILTON,
Attorney for Appellants.

ıted: March 10, 1963.

No. 17818

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

Eli Lubin and Glenn M. Tharp, Jr.,

Appellants,

vs.

United States of America,

Appellee.

PETITION FOR REHEARING.

Francis C. Whelan,
United States Attorney,

Thomas R. Sheridan,
Assistant United States Attorney,
Chief, Criminal Section,

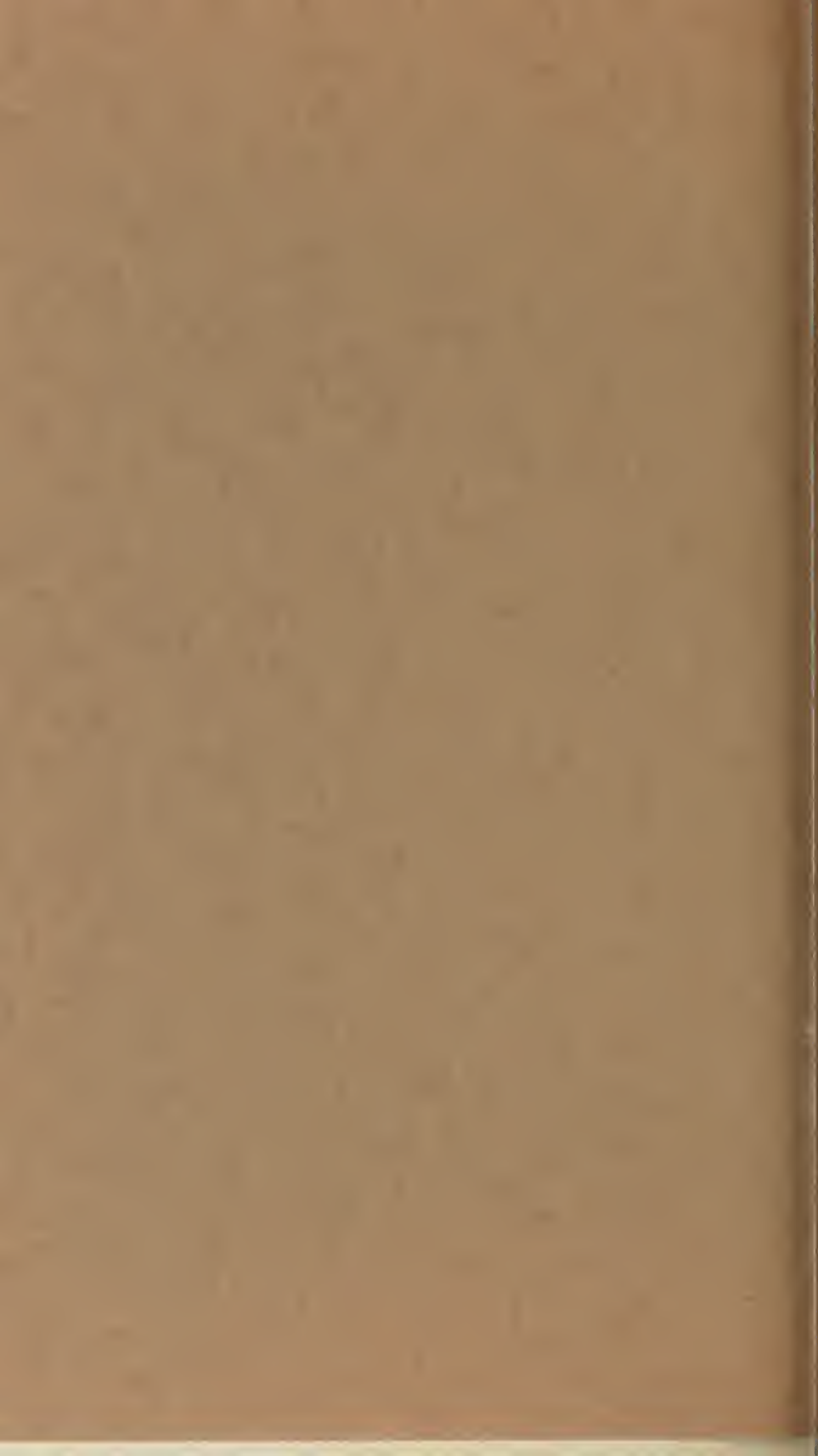
Timothy M. Thornton,
Assistant United States Attorney,

600 Federal Building,
Los Angeles 12, California,

Attorneys for Appellee,
United States of America,

Parker & Son, Inc., Law Printers, Los Angeles. Phone MA. 6-9171.

See also Vol. 3186



TOPICAL INDEX

PAGE

Grounds for granting a rehearing in this matter 2

TABLE OF AUTHORITIES CITED

Cases

Bryan v. United States, 338 U. S. 552 2

Donato v. United States, 302 F. 2d 468 3

Ogden v. United States, 303 F. 2d 724 4

Rules

Rules of the United States Court of Appeals, Rule 23 1

Statutes

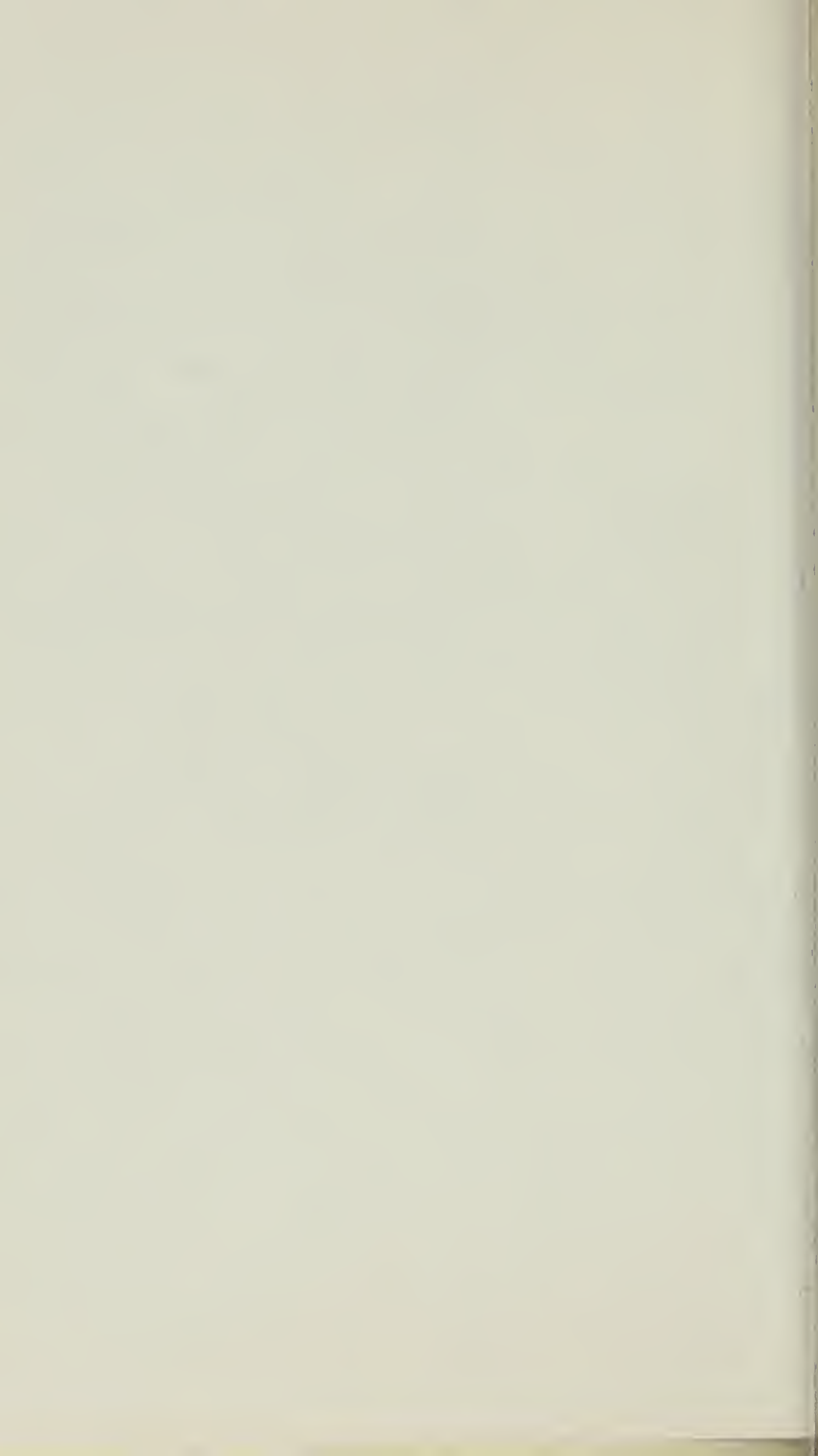
Penal Code, Sec. 182 3

Penal Code, Sec. 484 3

Penal Code, Sec. 800 3

United States Code, Title 18, Sec. 2113(b) 2

United States Code, Title 18, Sec. 2113(f) 2



No. 17818

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

ELI LUBIN and GLENN M. THARP, JR.,

Appellants,

vs.

UNITED STATES OF AMERICA,

Appellee.

PETITION FOR REHEARING.

Pursuant to Rule 23 of this Court, appellee herein respectfully petitions this Court for rehearing in the above-captioned cause.

Oral argument in this matter was heard on October 4, 1962, before Chief Circuit Judge Richard H. Chambers and Circuit Judges Frederick G. Hamley and Ben C. Duniway. The opinion and decision of this Court was filed on the 11th day of February, 1963, and this petition is filed herewith within the time provided therefor by provision of Rule 23 of this Court.

Attached hereto is a Certificate of Counsel for the Appellee pursuant to Rule 23 of this court that in his judgment the petition is well founded and is not interposed for delay.

Grounds for Granting a Rehearing in This Matter.

The decision of this Court reversed the judgment of the District Court on the grounds that the evidence did not sustain the conviction of appellants. The decision of the court made no further elaboration as to what action should be taken. Accordingly, the petition of appellee for rehearing is to determine (1) whether the appellants may be retried in the District Court on all issues in the case or (2) whether the case may be remanded to the District Court on the sole issue as to whether or not the money being transported by the Armored Transport of Los Angeles to the Los Angeles County General Hospital was "property or money . . . belonging to" a federally protected bank within the meaning of 18 U. S. C. Sec. 2113(b) and (f).

When a Judgment is reversed because the evidence is not sufficient to sustain a conviction and the appellant had made all proper and timely motions for acquittal in the United States District Court the Circuit Court of Appeals may direct a new trial.

Bryan v. United States, 338 U. S. 552 (1950).

The Court, in the next to the last paragraph of the decision, states ". . . that the proof would sustain conviction under the California law." In the ordinary situation it would be more expedient and practical to present this case to the proper authorities in the State Court for prosecution. However, in this case the record indicates the conspiracy terminated on approximately June 4, 1959, the date of the loss of a bag of currency containing $113,200. As this Court has pointed out the conspiracy to take money and property from the possession of Armored Transport of Los Angeles

would be an offense under the laws of California. (California Penal Code, Sec. 182, dealing with conspiracy, and 484 dealing with theft.) However, the applicable statute of limitations in the State of California for this offense is three years. (California Penal Code, Sec. 800.) Therefore, if the appellants are to be prosecuted on this evidence, it must needs be in the United States District Court for the Southern District of California.

Appellee accepts without qualification the considered opinion of this Court that an ambiguous stipulation should be interpreted in the favor of appellants. To appellee's knowledge this is a case of first impression. Appellee's complaint is that it relied in good faith on *its interpretation* of the stipulation which was not challenged throughout the trial by the appellants. Accordingly, appellee has not had its day in court to present evidence on the factual question of where legal title rested when the money was in the Armored Transport truck. This Court has quoted appellant Tharp's testimony on this issue. In order for the trial judge to convict appellant Tharp it was necessary to conclude that Tharp committed perjury in the course of his testimony. Accordingly, on this appeal this Court ought not to rely on any portion of the testimony of one who lied under oath. Furthermore, over government objection, Tharp was testifying to legal conclusions and to the contents of written documents although there was no showing that the documents were not in existence or reachable by a *subpoena duces tecum.*

Appellee desires to present on a rehearing an argument that the Court follow a procedure outlined in *Donato v. United States,* 302 F. 2d 468 at 470 (9th

Cir. 1962); and *Ogden v. United States,* 303 F. 2d 724 (9th Cir. 1962), (non-production of Jencks Act statement). Appellee believes that the issue of fact here may be resolved by remanding to the District Court the precise question as to whether or not the property being transported from a federally protected bank in downtown Los Angeles to the Los Angeles County General Hospital belonged to the bank at the time of transportation.

Respectfully submitted,

Francis C. Whelan,
United States Attorney,

Thomas R. Sheridan,
Assistant U. S. Attorney,
Chief, Criminal Section,

Timothy M. Thornton,
Assistant U. S. Attorney,

Attorneys for Appellee,
United States of America.

Certificate of Counsel.

Timothy M. Thornton, being Assistant United States Attorney and a member of the Bar of this Court and attorney of record for appellee herein, herewith certifies that this Petition For Rehearing is in his judgment well founded and is not interposed for delay.

Dated: March 11, 1963.

Timothy M. Thornton